

REMARKS

This application has been carefully reviewed in light of the final Office Action mailed September 1, 2006. At the time of the Office Action, Claims 1-29 were pending in the application. In the Office Action, the Examiner rejects Claims 1-29. Applicant respectfully requests reconsideration and allowance of all pending claims.

Section 112 Rejections

The Examiner rejects Claims 1, 8, and 12-17 under 35 U.S.C. 112, second paragraph. In the Office Action, the Examiner states:

Claim 1, 8 and 12-17 are rejected...as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections....The omitted structural cooperative relationships are: it is not clear the relationship between the icons and the status indicators.

(Office Action; page 3). Thus, the Examiner asserts that Claims 1, 8, and 12-17 omit “essential structural cooperative relationships” of particular elements.

Applicant traverses this rejection. In rejecting the above-referenced claims, the Examiner misinterprets the requirements of 35 U.S.C. 112, second paragraph. The Manual of Patent Examining Procedure (MPEP) recites:

A claim which omits matter disclosed to be essential to the invention *as described in the specification or in other statements of record* may be rejected under 35 U.S.C. 112, first paragraph, as not enabling....

In addition, a claim which fails to interrelate essential elements of the invention *as defined by applicant(s) in the specification* may be rejected under 35 U.S.C. 112, second paragraph, for failure to point out and distinctly claim the invention.

MPEP § 2172.01 (emphases added). Thus, a “structural cooperative relationship” between two elements is only required to be recited in the claims if it is “disclosed to be essential to the invention *as described in the specification or in other statements of record.*” MPEP § 2172.01 (emphasis added). Accordingly, if the specification does not disclose a particular cooperative relationship to be essential, then there is no requirement for such cooperative relationship to be recited in the claims. This principle is well-settled in case law. *See, e.g., Ex parte Nolden*, 149 USPQ 378, 380 (Bd. Pat. App. 1965); *Ex parte Huber*, 148 USPQ 447,

448-49 (Bd. Pat. App. 1965) (holding that a claim does not necessarily fail to comply with 35 U.S.C. 112, second paragraph, where the various elements do not function simultaneously, are not directly functionally related, do not directly intercooperate, and/or serve independent purposes).

In applying 35 U.S.C. 112, second paragraph, the Examiner fails to realize that, if the specification does not disclose a cooperative relationship to be essential, then there is no requirement for such cooperative relationship to be recited in the claims. Accordingly, the Examiner cannot maintain the rejection without showing that, with respect to the icon and the status indicator, the specification discloses a particular cooperative relationship to be essential. The Examiner has failed to make such a showing. The Office Action completely fails to establish that the specification discloses that *any* cooperative relationship is essential. Merely stating that “the relationship between the icons and the status indicators” is “not clear” does not satisfy the Examiner’s burden of showing that the specification discloses such relationship to be “essential.” Because the Examiner fails to show that the specification discloses a cooperative relationship to be essential, the Examiner cannot properly assert that Claims 1, 8, and 12-17 omit an “essential” structural cooperative relationship. Accordingly, the rejection of Claims 1, 8, and 12-17 is improper. For at least the foregoing reasons, Applicant respectfully requests reconsideration and allowance of Claims 1, 8, and 12-17.

Section 103 Rejections

Claims 1-2, 4-7, 12, 14, 16, 18, 20, 22, 23, and 27

The Examiner rejects Claims 1-2, 4-7, 12, 14, 16, 18, 20, 22, 23, and 27 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,112,015 issued to Planas et al. (“*Planas*”) and further in view of U.S. Patent No. 6,661,434 B1 issued to MacPhail (“*MacPhail*”). Applicant respectfully requests reconsideration and allowance of Claims 1-2, 4-7, 12, 14, 16, 18, 20, 22, 23, and 27.

In the Response dated June 21, 2006, Applicant argued that Claim 1 is entitled to a priority date that pre-dates the effective priority date of *MacPhail*. The present Application is a Continuation-in-Part of U.S. Application Serial No. 09/949,101, which is a Continuation of U.S. Application Serial No. 09/408,213 filed on September 27, 1999 (now U.S. Patent No.

6,289,380), which is a Continuation of U.S. Application Serial No. 08/892,919 filed on July 15, 1997 (now U.S. Patent No. 5,958,012), which claims priority to U.S. Provisional Serial Number 60/021,980 filed on July 18, 1996.

In the Office Action dated September 1, 2006, the Examiner maintained his reliance on *Planas* and *MacPhail*. The Examiner asserted that, pursuant to 37 C.F.R. § 1.78, Applicant must submit a petition to accept an unintentionally delayed benefit claim.

On November 22, 2006, Applicant filed a Petition to Accept Unintentionally Delayed Claim of Priority Pursuant to 37 C.F.R. § 1.78(a). Applicant notes that the elements of Claim 1 are adequately disclosed under 35 U.S.C. 112 in the above-referenced parent applications. Therefore, if Applicant's petition is granted, *Planas* and *MacPhail* cannot be considered prior art with respect to Claim 1. Consequently, the *Planas-MacPhail* combination will have to be withdrawn. For at least this reason, Applicant respectfully requests reconsideration and allowance of Claim 1.

In rejecting Claims 12, 14, and 16, the Examiner employs the same rationale used with respect to Claim 1. Accordingly, for at least the reasons stated above with respect to Claim 1, Applicant respectfully requests reconsideration and allowance of Claims 12, 14, and 16.

Claims 2, 4-7, 18, 20, 22, 23, and 27 depend from independent claims shown above to be allowable. In addition, these claims recite further elements not taught, suggested, or disclosed by the cited references. For at least these reasons, Applicant respectfully requests reconsideration and allowance of Claims 2, 4-7, 18, 20, 22, 23, and 27.

Claims 8-11, 13, 15, 17, 19, 25, and 29

The Examiner rejects Claims 8-11, 13, 15, 17, 19, 25, and 29 under 35 U.S.C. 103(a) as being unpatentable over *Planas* and further in view of U.S. Patent No. 6,577,323 B1 issued to Jamieson, et al. ("Jamieson"). Applicant respectfully requests reconsideration and allowance of Claims 8-11, 13, 15, 17, 19, 25, and 29.

The *Planas-Jamieson* combination is improper because the Office Action fails to properly identify any motivation for combining the teachings of *Planas* with the teachings of *Jamieson*. In the Response dated June 21, 2006, Applicant explained that *Jamieson* fails to

teach, suggest, or disclose “avoiding clutter of the display area,” as alleged by the Examiner. (Office Action dated March 21, 2006; page 7). In the present Office Action, the Examiner changes his position and states that avoiding clutter of a display area “is an obvious motivation known to anyone of ordinary skill in the art.” (Office Action dated September 1, 2006; page 14). The Examiner provides no documentary evidence to support this assertion. Applicant traverses the Examiner’s assertion and respectfully submits that “the examiner must provide documentary evidence in the next Office Action if the rejection is to be maintained.” MPEP § 2144.03(C). If the Examiner is relying on personal knowledge as support for the foregoing assertion, then “the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding.” MPEP § 2144.03(C). Otherwise the rejection must be withdrawn. For at least the foregoing reasons, Applicant respectfully requests reconsideration and allowance of Claim 8.

In rejecting Claims 13, 15, and 17, the Examiner employs the same rationale used with respect to Claim 8. Accordingly, for at least the reasons stated above with respect to Claim 8, Applicant respectfully requests reconsideration and allowance of Claims 13, 15, and 17.

Claims 9-11, 19, 25, and 29 depend from independent claims shown above to be allowable. In addition, these claims recite further elements not taught, suggested, or disclosed by the cited references. For at least these reasons, Applicant respectfully requests reconsideration and allowance of Claims 9-11, 19, 25, and 29.

Claim 3

The Examiner rejects Claim 3 under 35 U.S.C. 103(a) as being unpatentable over *Planas* as applied to Claim 1 above, and further in view of U.S. Patent No. 4,937,037 issued to Griffiths, et al. (“*Griffiths*”). In the Response dated June 21, 2006, Applicant argued that the *Planas-Griffiths* combination fails to teach, suggest, or disclose that “the status indicator has a reflective quality” as recited in Claim 3. Applicant explained that the “reflective areas” disclosed in *Griffiths* relate to the screen itself, not to the “the status indicator” as recited in Claim 3. In the present Office Action, the Examiner maintains the rejection and merely states: “[S]ince reflectivity is used to build a chart, Griffiths reference is relevant to the

claimed invention.” (Office Action; page 14). The Examiner’s statement misses the point. Regardless of whether *Griffiths* “is relevant to the claimed invention,” the rejection is improper if *Griffiths* fails to teach, suggest, or disclose that “the status indicator has a reflective quality” as recited in Claim 3. As explained in the prior Response, the “reflective and non-reflective areas” in the cited portion of *Griffiths* pertain to the properties of liquid crystal cells, (*Griffiths*; col. 3, ll. 36-40), not to a “status indicator” as recited in Claim 3. For at least this reason, Applicant respectfully requests reconsideration and allowance of Claim 3.

Claims 21, 24, 26, and 28

The Examiner rejects Claims 21, 24, 26, and 28 under 35 U.S.C. 103(a) as being unpatentable over *Planas* in view of *MacPhail* and further in view of U.S. Patent No. 6,289,380 issued to Battat, et al. (“*Battat*”). Applicant respectfully requests reconsideration and allowance of Claims 21, 24, 26, and 28.

Claims 21 and 26 depend from Claims 1 and 12, respectively. As explained above, *Planas* and *MacPhail* are not prior art with respect to at least Claims 1 and 12. Accordingly, the Examiner’s reliance on *Planas* and *MacPhail* must be withdrawn. As a result, Applicant respectfully requests reconsideration and allowance of Claims 24 and 26.

Claims 24 and 28 depend from Claims 8 and 13, respectively. As shown above, the rejection of Claims 8 and 13 is based on an improper combination of references. Because, Claims 8 and 13 are shown above to be allowable, Applicant respectfully requests reconsideration and allowance of Claims 24 and 28.

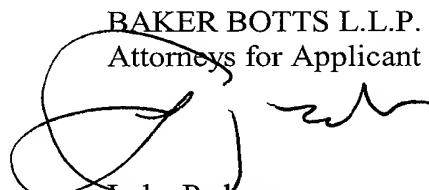
CONCLUSION

Applicant has made an earnest attempt to place this case in condition for allowance. For the foregoing reasons and for other reasons clearly apparent, Applicant respectfully requests reconsideration and full allowance of all pending claims.

If there are matters that can be discussed by telephone to further the prosecution of this Application, Applicant invites the Examiner to call the undersigned attorney at (214) 953-6655 at the Examiner's convenience.

Although Applicant believes no fees are due, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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